

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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U.S. PATENT AND TRADEMARK OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte SCOTT CLAIR and NEIL G. LONG

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Application No. 09/083,422

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ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

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This application was received electronically at the Board of Patent Appeals and Interferences (BPAI) on December 6, 2006. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below:

Appellants filed an Appeal Brief on January 19, 2006. 37 CFR § 41.37

(c)(1)(v) states in part:

(c)(1) The brief shall contain the following items under appropriate headings and in the order indicated . . .

. . .

(v) *Summary of claimed subject matter.* A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number and to the drawings, if any by reference characters.

...

(ix) *Evidence appendix.* An appendix containing copies of any evidence submitted pursuant to §§ 1.130, 1.131, or 1.132 . . .

(x) *Related proceedings appendix.* An appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of this section.

Appellants “V. SUMMARY OF THE CLAIMED SUBJECT MATTER” on pages 3-4 of the brief is a general description of the subject matter involved in the claims on appeal and does not specifically map the subject matter of each of the independent claims to its location in the specification as outlined above. Also, the brief in the instant application is lacking the headings **(ix) Evidence Appendix** and **(x) Related Proceedings Appendix.** The BPAI prefers all of the requisite headings placed in all appeal briefs filed under 37 CFR § 41.37, regardless of whether there is any matter relative to these headings or not.

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In addition, another matter that requires the examiner's attention before returning the application to the BPAI is as follows: The application Image File Wrapper (IFW) reflects filings of two petitions (April 26, 1999 and June 21, 1999) and a Supplemental Petition (May 10, 1999) that appear to be unanswered to by the examiner. No subsequent **Decisions On or Dismissal Of the Petitions** or any other subsequent action by the examiner were located that brings closure to them. Lastly, it is noted that there are no entries in the United States Patent and Trademark Office (USPTO) Patent Application Location and Monitoring (PALM) tracking system for the documents and no fee appears to have been charged for their filing. The BPAI requires proper closure on the documents before consideration of the application by the BPAI can proceed. Proper response to the petitions noted above is required.

Accordingly, it is

ORDERED that the application is returned to the Examiner:

- 1.) to hold the Appeal Brief filed January 19, 2006, defective for the reasons noted above and notification to appellants to file a substitute Appeal Brief in full compliance with 37 CFR § 41.37(c)(1);
- 2.) for consideration of the substitute Appeal Brief;

- 3.) for the examiner to properly respond to the petitions filed on April 26, 1999, May 10, 1999, and June 21, 1999 (please verify that all applicable fees in connection with the petitions have been paid);
- 4.) for the examiner to have a copy of the determinations on the petitions scanned into the application's IFW and entered into PALM, and
- 5.) for such further action as may be appropriate

BOARD OF PATENT APPEALS  
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